



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/082,846	06/29/93	MAASSAB	H 211500257

CAPITA, A EXAMINER

18N1/0506

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ART UNIT	PAPER NUMBER
1813	10

DATE MAILED: 05/06/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 11/26/93  
12/15/93  
2/7/94  
3/18/94  This action is made final.

A shortened statutory period for response to this action is set to expire  0 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

**Part II SUMMARY OF ACTION**

1.  Claims 1-17 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims \_\_\_\_\_ are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims 1-17 are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings  
are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the  
examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  
 been filed in parent application, serial no. \_\_\_\_\_, filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in  
accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

**EXAMINER'S ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-9, 12-17 drawn to nucleic acid sequence, a reassortant influenza virus comprising said nucleic acid, vaccine and method of treatment comprising said reassortant virus classified in Class 424, subclass 93A.

Group II. Claims 10, 11 drawn to polypeptide, classified in Class 424, subclass 89.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the protein can be made by Merrifield chemical synthesis. Further the two products, nucleic acid and protein differ structurally (i.e. amino acid vs. nucleotide) and biological properties (i.e. non-antigenic vs antigenic).

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I

- a. NS1-SEQ ID 1, 21
- b. NS2-SEQ ID 3, 23
- c. M-SEQ ID 5, 7, 25, 27
- d. NP-SEQ ID 9, 29
- e. PA-SEQ ID 11, 31
- f. PB1-SEQ ID 13, 33
- g. PB2-SEQ ID 15, 35
- h. NA-SEQ ID 17, 37
- i. HA-SEQ ID 19, 39
- j. combination thereof

Group II

- a. NS1-SEQ ID 2, 22
- b. NS2-SEQ ID 4, 24
- c. M-SEQ ID 5, 8, 26, 28

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- d. NP-SEQ ID 10, 30
- e. PA-SEQ ID 12, 32
- f. PB1-SEQ ID 14, 34
- g. PB2-SEQ ID 16, 36
- h. NA-SEQ ID 18, 38
- i. HA-SEQ ID, 20, 40
- j. combination thereof

The species are distinct since the polypeptides and nucleic acid encoded by said polypeptides contain a different amino acid (or nucleic acid) composition. Additionally the polypeptides differ in biological properties (i.e. antigenicity, molecular weight, etc). If applicants elect a combination thereof applicants are to provide a specific example to be examined in view of the multitude of combinations the claimed invention encompasses. Further, it is requested by the Examiner that applicants confirm the above Seq ID Nos. correspond to the corresponding proteins as set forth above.

5. Applicants are required under 35 U.S.C. § 121 to elect a single species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicants are advised that a response to this requirement must include an identification of the species that is elected

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consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

6. A telephone call was made to DeAnn F. Smith (Reg. No. 36,683) on May 2, 1994 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of

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inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Anthony C. Caputa whose telephone number is (703) 308-3995.

Anthony C. Caputa, Ph.D  
May 3, 1994



CHRISTINE M. NUCKER  
SUPERVISORY PATENT EXAMINER  
GROUP 180